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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/818,792	03/27/2001	Ronald P. Sansone	F-183	9874

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EXAMINER

WOO, RICHARD SUKYOON

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 07/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/818,792

Applicant(s)

SANSONE ET AL.

Examiner

Richard Woo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04-23-2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 04-30-04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

- 1) The Applicant's amendment filed on April 23, 2004 has been entered.
- 2) Applicant's arguments with respect to claims 1-35 have been considered but are moot in view of the new ground(s) of rejection. The new ground of rejection has been necessitated by the newly added limitations: transmitting the image to a data center where the image is processed by translating the image consisting of text and graphics to selected alphanumeric; and indicating the selected alphanumeric of the translated image.
- 3) The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

- 4) Claims 1-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. (US 2002/0095306 A1 or US 2002/0042808 A1) in view of Higgins et al. (US 5,754,671).

W.R.T. Claim 1:

Smith et al. discloses a method that enables a recipient to inform a carrier to deliver a mail in a plurality of manners, comprising the steps of:

depositing with the carrier mail containing the recipient's name and physical address and a sender's name and address (see Figs. 5-9 for the incoming mails and paragraphs [0022-0023] in 2002/0042808 for example);

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capturing the name and address of the recipient and the sender in the form an image (see Figs. 5-8, 11 and the descriptions thereof, paragraph [0032]);

translating the name and address of the recipient into an e-mail address (see paragraph [0015] with respect to e-mail service);

notifying the recipient of the expected delivery of the mail (see paragraphs [0014], [0017-0023]);

notifying the carrier of the manner in which the recipient wants the mail delivered (paragraphs [0022-0023]) and

delivering by the carrier mail to the recipient.

However, Smith et al. does not specifically disclose the method including: transmitting the image to a data center where the image is processed by translating the image consisting of text and graphics to selected alphanumeric; and indicating the selected alphanumeric of the translated image.

Higgins et al. is cited to show that the invention captures mail pieces in the form an image and translates the captured image into alphanumeric (for example, see Fig. 5 for the translation process; see Figs. 18-24 and the descriptions thereof).

Since both Higgins et al. and Smith et al. are both from the same field of endeavor of automatic mail processing, the purpose disclosed by Higgins et al. would have been well recognized in the pertinent art of Smith et al..

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Accordingly, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to replace the mail piece scanning process (which could take much memory storage due to each image's large file size) with the simple process that transmits the captured image to a data center where the image is processed by translating the image consisting of text and graphics to selected alphanumeric; and indicates the selected alphanumeric of the translated image, as taught by Higgins et al., for the purpose of providing an efficient and simple system that requires the less memory storage for each image file (just alphanumeric data) to save a significant amount of time and file size.

W.R.T. Claim 2: The modified Smith et al. further discloses the method wherein the recipient notifies the carrier to deliver the mail to a specified name and address (paragraphs [0015-0025]).

W.R.T. Claim 3: The modified Smith et al. further discloses the method wherein the recipient notifies the carrier to return the mail to the sender (see Id.).

W.R.T. Claim 11: The modified Smith et al. further discloses the method wherein the recipient notifies the carrier to deliver the mail to the recipient at a different address (see Supra Smith et al. paragraphs);

W.R.T. Claims 12-13: The modified Smith et al. further discloses the method wherein the recipient notifies the carrier to deliver the mail to the recipient by a slower or faster delivery than normal one (see Supra Smith et al. paragraphs 0015-0023);

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W.R.T. Claims 17-18: The modified Smith et al. further discloses the method including: informing the sender of the delivery of the mail; and wherein the recipient notifies the carrier to hold the mail (see Id.);

W.R.T. Claim 19: The modified Smith et al. further discloses the method wherein the recipient notifies the carrier to destroy (or trash in Smith et al.) the mail (paragraph 0022);

W.R.T. Claim 21: The modified Smith et al. further discloses the method wherein the recipient is notified via e-mail (see Supra Smith et al.);

W.R.T. Claim 25: The modified Smith et al. further discloses the method wherein the carrier is notified via e-mail (see Id.);

W.R.T. Claim 28: The modified Smith et al. further discloses the method wherein the recipient notifies a data center as to notify the carrier (see Supra Smith et al. paragraphs);

W.R.T. Claims 29-33: The modified Smith et al. further must include the mail inherently containing a stamp, a postal indicia, permit and symbology; and

W.R.T. Claims 34-35: The modified Smith et al. further discloses the method wherein the graphic is captured and translated and stored (see paragraph 0015, view "image").

As for Claims 4-10, 14-16, 20 and 22-24 and 26-27, the modified Smith et al. discloses the method as cited above and further discloses the method including:

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informing the carrier to e-mail the contents of the mail piece to the recipient (see Supra Smith et al.);

mailing by e-mail the contents of mail piece (see Id.);

informing the carrier to e-mail the contents of the mail piece to one or more specified e-mail addresses (see Id.); and

mailing by e-mail to the specified e-mail address (paragraphs 0015-0023, 0033).

However, the modified Smith et al. does not specifically disclose the method including the limitations in Claims 4, 7-10, 14-16, 20, 22-24 and 26-27 (opening the mail, sending the information contents to PDA, using facsimile, how to charge, recycling the mail, telephoning, and notifying via television).

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to arrange to open the mail, sending the information contents to PDA, notify via a facsimile, telephone or television, charge the recipient for the service and recycle the mail because Applicant has not disclosed that the above claimed limitations provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the modified method of Smith et al. because one of ordinary skill in the art may adopt other notification manners and incorporate them into the modified notification system of Smith et al...

Therefore, it would have been an obvious matter of design choice to further modify the modified invention of Smith et al. in view of Higgins et al. so as to obtain the invention as specified in claims 4, 7-10, 14-16, 20, 22-24 and 26-27.

Conclusion

5) Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard Woo whose telephone number is 703-308-7830. The examiner can normally be reached on Monday-Friday from 8:30 AM -5:00 PM.

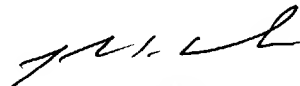
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703-308-2702. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0861.



Richard Woo
Patent Examiner
GAU 3629
June 1, 2004



JOHN G. WEISS
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